

Appl. No. 10/667,246  
Amdt. dated June 5, 2008  
Reply to Office Action of March 19, 2007

### Remarks

The present response replies to the final Official Action dated February 5, 2008. A petition for a one month extension of time and authorization to charge our credit card accompany this response. The Official Action stated that the reissue declaration filed with the application was defective, citing 37 C.F.R. 1.175(a)(1) and MPEP § 1414 with specific reference to MPEP 1414 II (b) and (c). The Official also rejected claims 26-53 under 35 U.S.C. 102(e) based on Swartz et al. U.S. Patent Publication No. 2003/0132298 (Swartz). The Official Action indicated that claims 1-25 would be allowable if based on a proper reissue declaration. The grounds of rejection are addressed below.

Claims 26-29, 32-35, 37-42, 44-47, 49-53 have been previously amended to be more clear and distinct. Claims 1-53 are presently pending.

### CLAIM STATUS

Original claims 1-25 are unchanged.

Claims 26-53 were previously added and are unchanged by the present Amendment. Claims 26-29, 32-35, 37-42, 44-47 and 49-53 were previously amended. The support for those amendments was set forth in the amendment filed September 18, 2007.

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### The Objection to the Reissue Declaration

This objection has been discussed with Examiner Labaze and Examiner Laballe and a draft declaration has been faxed to Mr. Laballe for his review. Upon finalizing the declaration, it will be signed by the inventor in Europe and filed.

### The Art Rejections

All of the art rejections hinge on the application of Swartz. As addressed in greater detail below, Swartz is not prior art and the reliance thereupon should be reconsidered and withdrawn. Further, the Applicant does not acquiesce in the analysis of Swartz made by the Official Action and respectfully traverses the Official Action's analysis underlying its rejections.

The Official Action rejected claims 26-53 under 35 U.S.C. 102(e) based on Swartz.

As an initial matter, Examiners Paik and Labaze are thanked for clarifying by phone that the Swartz item referred to in the Official Action as "Swartz 2003" is US Patent Publication No. 2003/0132298. It is noted that there are a great many Swartz patents and publications such that clarification was required to determine which item the Official Action relied upon.

Additionally, it is noted that Swartz is not prior art under 35 U.S.C. 102(e) as it is based on U.S. Application Serial No. 09/990,597 filed November 21, 2001 while the present reissue of U.S. Patent No. 6,296,185 is based on U.S. Application Serial No. 09/423,639 filed November 2, 1999, more than two years previously.

It is further noted, however, that the Swartz application claims to be a **continuation-in-part** of U.S. Application Serial No. 09/487,923 filed on January 19, 2000 which is in turn said to

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be a division of U.S. Application Serial No. 08/866,690 filed on May 30, 1997 and now abandoned. Further, earlier CIP relationships are also recited on the face of Swartz.

It appears that U.S. Application Serial No. 09/487,923 filed January 19, 2000 issued on May 9, 2006 as U.S. Patent No. 7,040,541, and if it is truly a divisional of U.S. Application No. 08/866,690 filed May 30, 1997, may be properly relied upon under 35 U.S.C. 102(e). The Examiner is urged to obtain a copy of U.S. Application No. 08/866,690 and confirm its correspondence to the disclosure of U.S. Patent No. 7,041,541 before proceeding further. If the two correspond, then the Examiner is requested to rely upon and apply U.S. Patent No. 7,040,541 if he chooses to do so.<sup>1</sup>

While the part of Swartz common to U.S. Patent No. 7,040,541 is prior art so long as U.S. Application Serial No. 09/990,597 is in fact a division of U.S. Application Serial No. 08/866,690 filed May 30, 1997, it is submitted that the myriad differences between Swartz and U.S. Patent No. 7,040,541 make isolating the common parts unduly burdensome and an impractical basis for further examination.

In the interest of expediting prosecution, it is noted that U.S. Patent No. 7,040,541 at col. 15, lines 30-56, states that a central host may "maintain a file of the customer's prior purchase records, and detect correlation of purchased items." It also addresses display of a message "dependent on

<sup>1</sup> While a relatively quick comparison of Swartz and U.S. Patent No. 7,040,541 has been made, the patent lacks Figs. 1A and 16-21 of Swartz and appears to lack all or parts of paragraphs 47, 50, 56-58, 63-82, 94, 95, 99-012, 105-124, 129-158, 178-191, 193-198, 200-206, 208-213, 215-233 and 248-258 of Swartz. Many other differences between the two disclosures may also be rapidly noticed.

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the customer's transaction list and prior purchasing history." However, as addressed in greater detail below this display does not appear to meet the terms of the present claims.

Claim 26, as previously amended, addresses a method of operating a retail terminal in a self-checkout transaction. That method comprises scanning an item for purchase into a retail terminal, displaying item information associated with said item for purchase on a display monitor **in response to scanning said item**, and displaying a customer-specific retail message on said display monitor, **contemporaneously with displaying said item information**, the customer-specific retail message being based on previous purchase information stored in a customer profile. (emphasis added) The limitations of claim 26 are not taught and are not made obvious by U.S. Patent No. 7,040,541.

U.S. Patent No. 7,040,541 is titled "Portable Shopping and Order Fulfillment System". As stated by its Abstract, it relates to "improved order fulfillment" utilizing a portable terminal, such as the ones illustrated in Figs. 2, 5, 11 and 12 and discussed at col. 7, line 51-col. 9, line 67. In a disclosed embodiment of its operation, a customer receives a portable terminal from a dispenser unit 230 upon entering a retail facility. As the customer proceeds through the retail facility, the bar code reader 240 of the terminal records purchases. Upon scanning, product information is displayed. Once the customer has completed product selection, the customer returns the bar code reader to the dispenser 230. Col. 9, lines 17-19.

Upon return of the bar code reader 240, information collected with the bar code reader is processed by a central processing unit and a ticket for the items is issued to the customer from a printer 232. Col. 9, lines 20-24. Alternatively, a card reader and data entry device are provided

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at a cash register 175. Once the central processing unit has successfully retrieved the customer information from the bar code reader 240, the customer proceeds to a checkout register 170 to pay for the products. Col. 9, lines 45-51.

While U.S. Patent No. 7,040,541 does address various aspects of self service checkout and the display of a variety of information. It does not appear to link the contemporaneous display of a customer-specific display based on previous purchase information stored in a customer profile contemporaneously with display of item information displayed in response to scanning the item. Claim 26, therefore defines over U.S. Patent No. 7,040,541 and should be allowed.

With slight variations in wording, claims 34, 35, 37, 46, 47, and 49 all address displaying a customer-specific retail message based on previous purchase information stored in a customer profile contemporaneously with display of item information generated as a result of entering an item for purchase by a customer. As noted above with respect to claim 26, these claimed features are not taught and are not made obvious by U.S. Patent No. 7,040,541. Claims 34, 35, 37, 46, 47, and 49 therefore should be allowed.

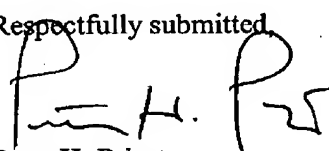
Claims 28, 38, 40 and 45 all address displaying a customer-specific retail message based on previous purchase information and displaying information associated with an item for purchase generated by scanning or entering the item for purchase. Claims 27, 29, 32, 39, 41, 42 and 44 all specify that the displayed item information includes "an item price and an item description" which are contemporaneously displayed with a customized retail message. U.S. Patent No. 7,041,541 does not appear to teach this claimed contemporaneous display.

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Conclusion

All of the presently pending claims, as amended, appearing to define over the applied references, withdrawal of the present rejection and prompt allowance are requested.

Respectfully submitted,



Peter H. Priest  
Reg. No. 30,210  
Priest & Goldstein, PLLC  
5015 Southpark Drive, Suite 230  
Durham, NC 27713-7736  
(919) 806-1600